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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/378,233      08/19/99      PALMER

W      2068.001

021917  
MCHALE & SLAVIN  
4440 PGA BLVD  
SUITE 402

IM22/0613

EXAMINER

BHAT, N

ART UNIT

PAPER NUMBER

PALM BEACH GARDENS FL 33410

1761

DATE MAILED:

06/13/01

*12*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/378,233

Applicant(s)

PALMER ET AL

Examiner

N. Bhat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6, 8, 10-12, 14-16, 18, 19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 8, 10-12, 14-16, 18, 19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

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## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. The request filed on May 21, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/378,233 is acceptable and a CPA has been established. An action on the CPA follows.

2. Action the merits of claims 2-4,6,8,10-12,14-16,18-19 and 21-27 follows:

3. Claims 2-4,6,8,10-12,14-16,18-19 and 21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21 applicant is advised to draft the claim using proper Markush language. Applicant should recite "...said rigid housing assembly including output means for producing at least one effect selected from the group consisting of sound, light movement, vibration, electrical stimulation and odor generation..." In claim 22, it is unclear what applicant is trying to claim, the claim is ubfuscatory. Suitable correction and/or explanation is required. Does applicant mean that when there is a sound wave effect or light effect generated in the holding device that this would somehow change the food on the handle?

4. Claims 2-4,6,8,10-12,14-16,18-19 and 23-27 are rejected as being dependent upon a rejected base claim.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 2,3,4,6, 21,22,24 and 25-27 rejected under 35 U.S.C. 102(e) as being anticipated by Filo et al.

Filo et al. teach a device and method transmitting sound waves between a signal source and user's ears wherein the sound can bypass the air which comprises an edible substance and a signal source operatively associated with the edible substance and configured to produce sound waves for transmission through the edible substance to a user's mouth from which they are conducted by teeth and bones to the user's ears to be perceived as a sound. The signal source alternatively may produce sound waves using a microphone or transducer device. Specifically the signal source can be any source configured to produce signals representatives of sounds desired. The signal source may be an electronic or piezoelectric device it include a dampened speaker, which is connected to the edible substance and further includes a power supply switch and/or housing. The amusement device of Filo et al. includes a grasping holder (14), which is held by a hand, which can actuate the signal source using switch (20) and placing the edible substance in contact with the mouth of the user. The signal source or transducer is connected to the holding device. Sound waves travel through the edible substance to the user's mouth where they are perceived as sound. [Note the abstract, column 2, lines 36-68 and column 3, lines 49-66] Filo et al. teach that the edible substance (12) can be any substance, which can be placed in the mouth of an individual and can be consumed. The combination amusement device and food of Filo et al. specifically provides a holding device comprising a rigid housing assembly having

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means for holding food, the food, and means for producing at least one effect, the effect being sound and further includes a power supply for energizing the output means which alters the one effect by physical interaction between the foodstuff member and the manipulator wherein said manipulation causes corresponding changes in the effect.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or no obviousness.

9. Claims 8, 10-12, 14-16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filo et al.

Filo et al. teach the invention substantially as claimed for reasons stated above.

However, Filo et al. does not specifically recite that effect of electrical stimulation is effective in altering the taste of food

It would have been obvious to one having ordinary skill in the art to provide a combination foodstuff holding device that produces and effect such as sound or light or an effect which will interact with the foodstuff which produces different effects based

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upon manipulation thereof by a manipulator because Filo et al. teaches a combination foodstuff and holding device that produces different effects based upon the manipulation thereof by a manipulator. The holding devices includes a rigid housing assembly having means for holding the foodstuff and a foodstuff member irremovably secured to the housing the rigid assembly including output means for producing sound wherein the amusement device is used by grasping holder (14) with a hand, actuating the signal source using switch (20) and placing the edible substance in contact with the mouth (22) of the user. The signal source or a transducer connected thereto produces sound waves (26). The sound waves travel through the edible substance to the user's mouth from which they travel through the user's teeth and bones to the user's ears. Filo et al. further teaches that the signal source comprises any source configured to produce signals representative of sound. Filo et al. teach that the term sound refers to both compression waves and sound waves. The sound sources include preprogrammed microprocessor chips, musical instruments, radios, and tape or compact disc players, examples of sounds generated by the sound sources include music, noises and spoken words. The amusement devices can be configured to receive variable, radio signals. The signals may originate from commercial AM/FM radio stations, or it may originate from dedicated transmitters broadcasting at special frequencies. It would have been obvious to one of ordinary skill that the sound waves which is interact with the food and the user's mouth as taught in Filo et al. is similar to what applicant has taught the and therefore, the similarly one of ordinary skill would expect that there would be alteration of taste in the foodstuff. With respect to the limitations of claim 8 m 10, 11, 12 wherein

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the output means includes a micro controller, voltage -controlled oscillator, capacitance etc. These output means are well within the skill of the ordinary artisan especially when read in light of the teachings of Filo et al. who teaches that the combination food amusement device can includes preprogrammed microprocessor chips, musical instruments, radios, tape or compact disc players. [Note column 4, lines 36-39] To provide a micro controller, microprocessor, the control, electrical components, which controls the microprocessor and micro controller, are obvious expedients absent criticality in showing.

10. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filo et al. in combination with Bryan.

Filo et al. teaches the invention substantially as claimed for reason noted above.

Filo et al. does not teach that the foodstuff is optically conduct and the control means regulates the sound based upon an amount of light passing the light-registering member through the foodstuff.

Bryan teaches a bioluminescent novelty items which include toys, paints, foods, beer, icings, frostings beverages, ice etc. Specifically, a combination, which includes a beverage and one or more bioluminescent enzymes. The combination further includes active agent which will permit the combination to illuminate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a holder and food combination described by Filo et al. which includes the food and bioluminescence generating system of Bryan to provide a novelty item as claimed because Bryan teaches that the bioluminescence article of

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manufacture combination can be used used in many types of food. Filo et al. teaches that the food employed in the invention can be any food thus permitting the substitution of the food article such as taught by Bryan which produces an optical effect to be used as the food in the food combination of Filo et al. thus rendering the invention as a whole obvious.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879.

The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat  
Primary Examiner  
Art Unit 1761

June 12, 2001

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